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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,321	07/18/2003	Bruce A. Raming	31536-DIV1	3273
23589	7590	06/08/2004	EXAMINER	
HOVEY WILLIAMS LLP 2405 GRAND BLVD., SUITE 400 KANSAS CITY, MO 64108			HENDERSON, MARK T	
		ART UNIT	PAPER NUMBER	
			3722	

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/623,321	RAMING, BRUCE A.
	Examiner	Art Unit
	Mark T Henderson	3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-43 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3,6-8,13-17,22-25 and 30-35 is/are rejected.  
 7) Claim(s) 4, 5, 9-12, 18-21, 26-29, 36-43 is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 7/18/03.

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: Attachment 1.

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1, 6-7, 17, 22-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 8 of U.S. Patent No. 6,616,189 in view of Bartl (5,340,158). Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose a first substrate or ply having indicia, a front side, a back side; having adhesive applied to a part of the backside which surrounds a central portion or first portion of the first substrate or ply; a second substrate or ply having sides and edges; and lines of weakness defining a second central section or portion removable along the lines of weakness from a surrounding border portion; a tear strip; and indicia on the first and second substrates or plies.

However, Ramings ('189) does not disclose: the first ply being a packing list having a leading margin, a trailing margin, and side margins, and the second ply being a shipping label;

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whereby the shipping label substrate may be placed in registry with the packing list substrate with the packing list margins inboard of the shipping label edges; and wherein the packing list and shipping label further includes scannable indicia.

Bartl discloses in Fig. 3, a packing list substrate (37) with a leading margin (37C), a trailing margin (37D), and side margins (37E).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ramings' shipping and packing label system and container with a packing list having margins as taught by Bartl for the purpose of structuring a packing list form in an organized manner.

In regards **Claims 6, 7, and 22**, wherein the shipping label may be placed in registry with the packing list with the packing list margins inboard of the shipping label edges; and in which the list and label indicia being scannable, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the shipping label Ramings ('189) is capable of being placed in registry with the packing list depending on how the end user wants to package the list and label, and further the indicia of Ramings is capable of being scannable depending on what the end user wants to do with the information.

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Furthermore, in regards to **Claim 1**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any indicia on the first ply or sheet, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which required for patentability. Therefore, it would have been obvious to include any type of indicia on the first substrates or ply, since applicant has not disclosed the criticality of having particular list indicia, and indicia would function equally as well any type of indicia printed on the first substrate or ply.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 17, 23, 25 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Bartl (5,340,158).

Bartl discloses a label system comprising: a container (Col. 2, lines 37-38) having a face (11) adapted to receive a first sheet (37); a first sheet (37 as shown in Attachment I) including a front side (37A), a back side (37B), a leading margin (37C), a trailing margin (37D), first and second side margins (37E), a first portion (a) having a length and a width, and a second portion (B), wherein the adhesive is applied to at least (or all) of the back side (37B) of the second portion (B); a second sheet (13) separate from and discrete from the first sheet (37), wherein the second sheet includes a face side (13A), a rear side (13B), a leading edge (13C), a trailing edge (13D), first and second side edges (13E), lines of weakness (17) defining a center section (19) removable along the lines of weakness from a surrounding border (13F, as seen in Fig. 1); adhesive (Col. 2, lines 37-40) applied to at least (or all) a portion of the rear side (13B) of the border, whereby the second sheet (13) may be placed in registry with the first sheet (37) with the first sheet margins (37C, 37D and 37E) inboard of the second sheet edges (13C, 13D and 13E, as seen in Fig. 3); wherein the second sheet further includes an additional line of weakness (seen in Fig. 1) extending between side margins (37E) to define a tear strip (first tab) positioned adjacent the center section (19).

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3. Claims 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Bartl.

Bartl discloses in Fig. 1 and 3, a container (or package) having a face (11) adapted to receive a first sheet (13); wherein the first sheet includes a face side (13A), a rear side (13B), a leading edge (13C), a trailing edge, and side edges (13E), first and second longitudinally extending lines (17A and 17B) extending parallel to the side edges; a cross line of weakness (17C) parallel to the leading edge (13C); and an inboard transverse line of weakness (17D), all defining a center section free of adhesive and removable from a surrounding border (21); and a second sheet (37) having a front and back side, wherein the back side is adhesively mounted to the container (or package).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray (4,429,827) in view of Bartl.

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Murray discloses in Fig. 1, a shipping and packing label system comprising a substrate (23, 26 and 27) listing packing information indicia, having a front side, back side, a leading margin, a trailing margin, first and second side margins, a first portion (23) free of adhesive on both sides, having a length and a width, a second portion (27) having adhesive applied to the back side; a first longitudinally extending line of weakness (28) and a parallel second (29) line of weakness in which both extend substantially between the leading and trailing margins, and defining a third portion (27) having adhesive; wherein the first portion is positioned between the second and third portion and separable therefrom; and a separable and discrete (32) having a face and rear sides, a leading edge, a trailing edge, and side edges.

However, Murray does not disclose a shipping label comprising lines of weakness defining a removable center section from a surrounding border portion.

Bartl discloses in Fig. 1 and 3, a second sheet label (13) separate from and discrete from the first sheet (37), wherein the second sheet includes a face side (13A), a rear side (13B), a leading edge (13C), a trailing edge (13D), first and second side edges (13E), lines of weakness (17) defining a center section (19) removable along the lines of weakness from a surrounding border (13F, as seen in Fig. 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Murray's shipping and packing label system with a label with a removable center section as taught by Bartl for the purpose of hiding a portion of the first substrate for security purposes until removed by end user.

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In regards **Claim 1**, whereby the shipping label may be placed in registry with the packing list with the packing list margins inboard of the shipping label edges, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the label substrate and list substrate of Murray as modified by Bartl are capable of being placed in registry with one another depending on how the end user wants to package the list and label.

5. Claims 22 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartl in view of Michelin et al (5,776,571).

Bartl discloses a label system comprising all the elements as claimed in Claim 17 and 25, and as set forth above. However, Bartl does not disclose: wherein the first sheet further comprises scannable indicia on the front face and wherein the second sheet includes scannable indicia on the face side corresponding to the scannable indicia on the first sheet.

Michelin et al discloses in Fig. 8-10, a label system comprising a first sheet (11) comprising indicia on a front face and a second sheet (12) comprising indicia on a face side; wherein both indicia corresponds with one another (Col. 2, lines 4-11).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bartl's label system with indicia written on faces of the first and second sheet as taught by Michelin et al for the purpose of holding various type of information for an end user.

In regards to the indicia being scannable, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the indicia of Michelin et al is capable of being scannable depending on what the end user wants to do with the information.

6. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartl in view of Michelin et al (5,776,571) and further in view of Knoll et al.

Bartl as modified by Michelin et al discloses a label system comprising all the elements as claimed in Claim 25 and 30, and as set forth above. However, Bartl does not disclose: wherein the container (or package) has scannable indicia which corresponds to the first sheet.

Knoll et al discloses in Fig. 4, a label system comprising a first sheet (12) comprising indicia, and a second sheet (23) comprising indicia, and a container comprising indicia.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bartl's and Michelin et al's label system with indicia written on the face of a container as taught by Knoll et al for the purpose of holding various type of information for an end user.

In regards to container indicia being scannable and corresponding to the first sheet indicia, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the container indicia of Knoll et al is capable of being scannable and corresponding to the first sheet indicia depending on what the end user wishes to do with the information.

***Allowable Subject Matter***

7. Claims 4, 5, 9-12, 18-21, 26-29, 36-43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Raming, Ashby, Kouramanis, Allen et al, Chigot, Raming ('518), Main, and Raming ('554), Chess, Nixon et al, Roshkoff, Webendorfer et al, Shishido, and O'Brien discloses similar label systems.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, a. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.

  
MTH

June 1, 2004

  
A. L. WELLINGTON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700